

REMARKS

Claims 13-19 are pending in this application, claim 14 having been amended and new claims 16-19 having been added by this amendment. Attached hereto is a marked-up version of the changes made to claim 14 by the current amendment. The attachment is captioned "Version with markings to show changes made."

The Office Action dated April 16, 2002 rejected claims 13-15 for obviousness-type double patenting and rejected claims 13 and 15 as being obvious over U.S. Patent No. 5,204,955 to Kagei. Applicants gratefully acknowledge the indication that claim 14 would be allowable if rewritten in independent form including all of the limitations of the base claim.

Double Patenting

The grounds for the obviousness-type double patenting rejection of claims 13-15 is set forth in part 4 on pages 2-3 of the Office Action. Applicants have submitted a terminal disclaimer herewith to overcome the obviousness-type double patenting rejection. Applicants respectfully request that the obviousness-type double patenting rejection be withdrawn.

Obviousness Rejection of Claim 13

The grounds for the obviousness rejection of claim 13 is set forth in part 6 on pages 4-5 of the Office Action. The rejection relies only upon U.S. Patent No. 5,204,955 to Kagei to reject the claims. Applicants respectfully traverse the rejection because it is wholly inadequate to establish even a *prima facie* case that each and every one of the combination of features recited in claims 13 and 15 is suggested by the prior art.

A careful inspection of the obviousness rejection reveals that it repeats those features of claim 13 which are disclosed by Kagei. The following version of claim 13 includes underlining to indicate those features of claim 13 that the obviousness rejection indicates are not disclosed by Kagei:

13. A device comprising:

a power unit;

means for accepting an instruction for controlling said power unit from a managing computer via a network;

a power unit controlling controller for converting said instruction into a power unit control signal; and

means for performing control of said power unit based on said power unit control signal from said power unit controlling controller.

The rejection acknowledges that "Kagei does not explicitly disclose (sic) that the test management is for controlling a power unit." Nevertheless, the rejection concludes that it would have been obvious "to recognize that the teaching of Kagei can also be implemented for testing a power unit" and "to include a power unit into the teaching of Kagei in order to provide an autonomous power unit test function."

Initially, applicants wish to point out that claim 13 is not limited to "test management", "testing a power unit", or "an autonomous power unit test function". Rather, claim 13 merely recites control of a power unit. While the control recited in claim 13 may be exercised for purposes of a test, there are no testing limitations in claim 13.

Although Kagai may disclose test management and an autonomous test function of a subnetwork management system, the rejection improperly relies on the proposition "that the teaching of Kagai can also be implemented for testing a power unit". Applicants do not agree that the subnetwork management subsystem can be easily modified without undue experimentation to provide for testing or other types of control of a power unit. The rejection cites no other reference to support the contention that Kagai can be modified to provide for testing of the power unit.

Moreover, the rejection cites no other reference which provides any suggestion or motivation for attempting to modify Kagai so as to provide for testing of the power unit. To the contrary, it is this application which states the advantages of the device recited in claim 13. In other words, there would be no reason to suggest that Kagai should be modified in the manner proposed in the rejection were it not for the hindsight provided by this application.

According to the Manual of Patent Examining Procedure (MPEP), a secondary reference must be cited to support an obviousness rejection based upon

the modification of Kagei. Absent such a secondary reference, the rejection of claim 13 fails to establish even a *prima facie* case of obviousness and should be withdrawn.

Objection to Claim 14

The objection to claim 14 is set forth in part 3 on page 2 of the Office Action. The objection indicates that claim 14 would be allowable if rewritten in independent form including all of the limitations of the base claim. Applicants have amended claim 14 to be in independent form including all of the limitations of the base claim. Attached hereto is a marked-up version of the changes made to claim 14 by the current amendment. The attachment is captioned "**Version with markings to show changes made.**" Applicants respectfully submit that claim 14 is now in condition for allowance.

Obviousness Rejection of Claim 15

The grounds for the obviousness rejection of dependent claim 15 is purportedly set forth in part 6 on pages 4-5 of the Office Action. The rejection relies only upon U.S. Patent No. 5,204,955 to Kagei to reject the claims. However, the rejection never refers to the feature recited in dependent claim 15. Kagei may disclose a server to be managed. However, in addition to the reasons set forth above with respect to claim 13 arguing that Kagei does not make it obvious to

control the power unit of a device, applicants also respectfully submit that it is even less obvious to control the power unit of a server. Typically, it is the client computer in a client/server network which is controlled rather than the server.

New Claims 16-18

New claim 16 is dependent on claim 13 and recites the further feature that the power unit controlling controller comprises hardware. Exemplary, non-limiting, support for the feature is provided by power controller 121 in Fig. 1 of the originally filed application.

Applicants can find no suggestion of a hardware power unit controlling controller in Fig. 45 of Kagei, the only figure which appears to show any hardware features of subnetwork management system 20, and can find no suggestion of the recited combination of features in claim 16 including the hardware power unit controlling controller.

Claims 17 is the same as claim 15, except that it is dependent on claim 16 instead of claim 13. Applicants respectfully submit that claim 17 is allowable for at least the same reasons as set forth above for claims 15 and 16.

Claims 18 and 19 are dependent on claim 16 and recite additional features relating to the hardware power unit controlling controller. Applicants respectfully submit that claims 18 and 19 are allowable at least because these additional

features are not suggested Kagei and that the combination including these additional features is not suggested by any of the cited references.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this Amendment or the accompanying Terminal Disclaimer, or credit any overpayment of fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (500.34601CC3).

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



Robert M. Bauer, Registration No. 34,487

RMB:cas
(703) 312-6600

Attachment

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Claim 14 has been amended to read as follows:

14. A device comprising:

a power unit;

means for accepting an instruction for controlling said power unit from a managing computer via a network;

a power unit controlling controller for converting said instruction into a power unit control signal; and

means for performing control of said power unit based on said power unit control signal from said power unit controlling controller, according to claim 13

wherein said power unit controlling controller comprises:

means for detecting a result and state of power unity control for said device; and

means for transmitting said detected result and state from said detecting means to said managing computer via said network.